

## **REMARKS**

Before, Applicants had sent a response dated October 24, 2003 under 37 C.F.R. §1.116 in response to a Final Office Action. Applicants request the Examiner to disregard the previous response sent October 24, 2003 and to reconsider this case based on the present amendment.

Previously, Claims 39-47 and 49-51 were pending in this application and stood rejected on various grounds. The Examiner had stated that Applicants were entitled to the priority of PCT application No. PCT/US98/19330, filed 9/16/98 based on "induction of chondrocyte redifferentiation." However, Applicants have discovered that the cited PCT application lacks adequate support for the "chondrocyte redifferentiation" assay. Hence, Applicants base the utility of PRO224 in this application on the "inhibition of endothelial cell growth" assay (Assay 9), which was first disclosed in PCT/US98/19330 filed 9/16/1998, at least at pages 170-172. Present claims have been amended accordingly with the recitation "inhibition of endothelial cell growth." Applicants submit that no new matter has been added due to these amendments.

Applicants address the rejections in the final Office action as applied to the amended claims, and respectfully traverse the rejections.

### **Claim Rejections - 35 U.S.C. §112, Second Paragraph**

Claims 39-47, 49-51 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for still reciting part (b) that recited "the polypeptide,.....lacking its associated signal sequence".

Applicants submit that this recitation is definite because Figure 46 clearly discloses that the signal sequence is from amino acid 1-30. Hence, a person skilled in the relevant art would know exactly what was meant by "the amino acid sequence of the polypeptide shown in Figure 46 (SEQ ID NO:127), lacking its associated signal peptide" recited in part (b) of the claims.

Accordingly this rejection should be withdrawn.

### **Claim Rejections – 35 U.S.C. §112 - Enablement**

Claims 39-43 were rejected under 35 U.S.C. §112, first paragraph, for alleged lack of enablement. These rejections are addressed as applied to amended Claims 39-43.

Applicants have amended the claims to recite "inhibition of endothelial cell growth." Support for this utility can be found at pages 170-172 of PCT/US98/19330 filed September 16, 1998 and also at page 204, Example 66 of the present specification. Applicants have thus enabled Claims 39-43 and hence, this rejection should be withdrawn.

#### **Claim Rejections - 35 U.S.C. §102(b)**

Claims 39-47 were rejected under 35 U.S.C. §102(b) as being anticipated by Kato *et al.* (WO99/43802, dated September 1999).

The effective filing date for this application is September 16, 1998 which is before the September 1999 date of the cited prior art. Hence, WO 99/43802 is not prior art and this rejection should be withdrawn.

#### **Claim Rejections - 35 U.S.C. §103**

Claims 50 and 51 were rejected under 35 U.S.C. §103 as being unpatentable over Kato *et al.* (WO99/43802, dated September 1999) in view of Boyle U.S. Patent No. 6,284,485B1.

As discussed above, the primary reference Kato is not prior art, since it is dated after the effective filing date of the present application. Accordingly, this rejection falls and hence, this rejection should be withdrawn.

#### **Claim objection**

Claim 49 was objected to for depending from a rejected claim.

Applicants believe that Claim 44, upon which Claim 49 depends, is now free of 102(b) prior art and should not be a rejected claim. Accordingly, the objection to Claim 49 should be withdrawn.

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. **08-1641** (Attorney Docket No. **39780-1618 P2C13**). Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

Date: December 8, 2003

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